

Docket No. 200314587-1

Remarks

This Amendment is responsive to the Notice of Non-Compliant Amendment dated February 27, 2008. Reexamination and reconsideration of claims 1-13, 17-20, and 25 is respectfully requested.

Summary of The Office Action

Claims 21-24 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b).

The drawings were objected to under 37 CFR 1.83(a) for purportedly not showing every feature of the invention specified in the claims.

Claims 1-7, 8-13, 17-20 and 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ishizaki et al. (U.S. Pat. No. 5,874,738)(Ishizaki). Arguments are presented to show why these claims are not obvious in light of Ishizaki.

Amendment to Drawings

The drawings were objected to under 37 CFR 1.83(a) for purportedly not showing every feature of the invention specified in the claims. Servo 660 is added to drawing 7 and corrected drawings in compliance with 37 CFR 1.121(d) are provided as Replacement Sheet for Figure 7. Paragraph [0032] is now amended by adding the reference number "660" to the previously appearing term "servo" and thus no new matter was added.

The Claims Patentably Distinguish Over the References of Record

35 U.S.C. §103

Claims 1-13, 17-20, and 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ishizaki. To establish a prima facie case of 35 U.S.C. §103 obviousness the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.03. Here, the criteria described in MPEP 2143.03 is not satisfied since the reference does not teach or suggest all the claim limitations. The reference does not teach a servo for automatically applying a configurable frictional force in a monitor stand height adjustment mechanism. Thus, none of the claims are obvious for at least this reason.

The Office Action asserts that it would have been obvious to one having ordinary skill in the art at the time the invention was made to add the claimed servo to Ishizaki. Yet no reference in an analogous art is provided to support this assertion. Additionally, this unsupported assertion is incorrect.

The assertion is flawed because the Office Action provides no teaching, suggestion, or motivation why anyone would combine the reference with a servo. Indeed, the servo is pulled from thin air and added, using hindsight reconstruction, to the reference. Hindsight reconstruction using the patent as a blueprint has long been invalid.

Hindsight reconstruction has long been frowned upon:

A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, all facts must be considered. The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is

patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1987), cert. denied, 389 U.S. 1057 (1988) (emphases in original).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), MPEP 2143.01

Here, the Office Action has determined obviousness through hindsight reconstruction, using the application as a blueprint, which is clearly impermissible. For at least this reason all the independent claims are not obvious and are in condition for allowance.

The assertion is additionally flawed because there is no indication that adding the servo to the reference would produce the claimed device. It appears that a wrench must be employed to turn the screw in the reference making it unlikely that a servo could be added to the reference to perform the detecting and automatic application of the configurable frictional force. For at least this additional reason all the independent claims are not obvious and are in condition for allowance.

The Office Action is flawed because it relies solely on case law to support its rejection, when the MPEP specifically counsels against relying solely on such case law. The Office Action relies on In re Venner, 120 USPQ 192, to support its assertion that adding the servo would be obvious. The Office Action asserts that In re Venner held that "providing a mechanical or automatic means to control or replace manual activity, which has accomplished the same result involves only routine skill in the art." However, Venner is inappropriately cited here. In Venner, obviousness was found because a timer and solenoid were simply added to an existing mold clamp to open the mold clamp after a pre-determined period of time.

Here, there is no such pre-determined period of time and no simple addition of an existing element to another existing element. Here, a servo is operably connected to an element (second assembly) and is configured to produce a configurable friction force. This configurable force will facilitate keeping a monitor in a chosen position without locking the monitor. The servo can be programmed to detect whether it has moved and if it has to work on an element like a screw, lever, or plate to increase the frictional force.

Existing monitor stands cannot detect when the monitor they are supporting is slipping. This slipping may occur if the weight of the monitor changes and/or if the "fixed lifting force" provided by the first assembly changes unexpectedly. The weight of the monitor may change if, for example, a coffee cup is placed on top of the monitor, a large number of post-its are attached to the monitor, if there is a change in atmospheric pressure (e.g., in an airplane, undersea), if there is a change in gravitational force (e.g., takeoff, landing, entering space) and so on. The servo could account for these changes. This distinguishes adding a servo from adding a timer to a clamp mold in that no manual process (e.g., manually detecting weight change) is being replaced. A new function is being added by the servo. Similarly, existing monitor stands cannot detect that a heavier monitor has been placed on the stand. There is no conventional, manual step of weighing a monitor before placing it on a stand that is replaced by a weighing function in the claim. Instead, the difference in weight, within bounds, can be accounted for by automatically providing the configurable friction force. For at least these reasons, the servo of claims 1 and 8 distinguish over both the prior art and the inappropriately cited Verner.

Verner's more frequently cited for the proposition that using a computer to automate a process does not in and of itself impart non-obviousness to the process. This application of Verner is also inappropriate in the present case. It is to be noted that the quotation used by the Office Action to support its assertion of

obviousness resides in a section of the MPEP that cautions Examiners NOT to rely solely on case law (e.g., Verner). The relevant section reads:

2144.04 Legal Precedent as Source of Supporting Rationale [R-1]

As discussed in MPEP § 2144, if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court. Examples directed to various common practices which the court has held normally require only ordinary skill in the art and hence are considered routine expedients are discussed below. If the applicant has demonstrated the criticality of a specific limitation, it **would not be appropriate to rely solely on case law** as the rationale to support an obviousness rejection.

Here, the Office Action relies solely on case law, provides no reference where a servo has been employed in a monitor height adjustment stand, does not analogize the facts of the present case to the timer/solenoid/mold clamp of Verner, and relies on a case whose facts have clearly been distinguished from the present application. For at least these reasons none of the claims are obvious and all of the claims are in condition for allowance.

Independent Claim 1

This claim concerns a monitor stand height adjustment mechanism that includes a first assembly that produces a fixed lifting force and a second assembly that produces a configurable friction force. Applicant agrees that Ishizaki shows both of these elements. This claim also recites a monitor support assembly and a monitor support assembly guide. Applicant also agrees that Ishizaki shows both of these elements. However, this claim also recites a servo operably connected to the second assembly for moving the second assembly to produce the configurable

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friction force." The Office Action agrees that Ishizaki does not show this element. As demonstrated above, the Office Action fails to establish a prima facie case of obviousness and inappropriately relies solely on case law to reach its conclusion of obviousness. For at least the flaws laid out above, claim 1 has been shown to be not obvious and in condition for allowance. Accordingly, those claims that depend from claim 1 are similarly not obvious and are in condition for allowance.

Independent Claim 8

This claim recites "a friction assembly ... to produce an automatically applied frictional force between the guide and the attachment assembly", and "a servo operably connected to the friction assembly, and configured to facilitate selectively establishing and automatically moving the friction assembly to produce an amount of the automatically applied frictional force". The Office Action agrees that Ishizaki does not show these elements. As demonstrated above, the Office Action fails to establish a prima facie case of obviousness and inappropriately relies solely on case law to reach its conclusion of obviousness. For at least the flaws laid out above, this claim has been shown to be not obvious and in condition for allowance. Accordingly, those claims that depend from claim 8 are similarly not obvious and are in condition for allowance.

Independent Claim 17

This claim recites "means for automatically applying the frictional force between the means for guiding the direction of travel and the means for applying the lifting force." The Office Action admits that Ishizaki does not show the automatic application of the frictional force. As demonstrated above, the Office Action fails to establish a prima facie case of obviousness and inappropriately

relies solely on case law to reach its conclusion of obviousness. For at least the flaws laid out above, this claim has been shown to be not obvious and in condition for allowance. Accordingly, those claims that depend from this claim are similarly not obvious and are in condition for allowance.

Independent Claim 20

This claim recites "a second assembly ... to produce an automatically applied configurable frictional force". The Office Action admits that Ishizaki does not show the automatically applied frictional force. As demonstrated above, the Office Action fails to establish a prima facie case of obviousness and inappropriately relies solely on case law to reach its conclusion of obviousness. For at least the flaws laid out above, this claim has been shown to be not obvious and in condition for allowance. Accordingly, those claims that depend from this claim are similarly not obvious and are in condition for allowance.

Conclusion

For the reasons set forth above, claims 1-13, 17-20, and 25 patentably and unobviously distinguish over the reference and should now be allowed. An early allowance of these claims is respectfully requested.

Respectfully submitted,



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